

### **REMARKS**

Claims 1-5, 7-20, and 22-34 are currently pending with Claims 1, 16, 31, 33, and 34 being the independent claims. Claims 3 and 18 are amended to correct a minor informality in these claims. Claims 16 and 31-34 are amended and find support throughout the specification, for example, at page 7, lines 12-13. No new matter is added by these amendments.

In the Office Action, Claims 1, 9 – 12, 14 – 16, 24 – 27, and 29 – 34 were rejected as allegedly being obvious over U.S. Patent Application Publication No. 2002/01511441 to Srinivasan et al. (“Srinivasan ‘441”). Claims 1 – 5, 7 – 8, 13 – 20, 22 – 23, and 28 – 31 were rejected as allegedly being obvious over U.S. Patent No. 5,089,156 to Chrisope et al. (“Chrisope”) in view of the Srinivasan ‘441 application. Finally, Claims 1, 12, 14 – 16, 27, and 29 – 34 were rejected as allegedly being obvious over U.S. Patent No. 5,578,236 to Srinivasan et al. (“Srinivasan ‘236”) in view of the Srinivasan ‘441 application.

Each of the foregoing rejections is respectfully traversed and favorable reconsideration is requested in view of the above amendments and following remarks.

#### **Rejections Based on the Srinivasan ‘441 Application.**

The Examiner’s initial obviousness rejections are based upon the Srinivasan ‘441 application, taken by itself with no supporting reference. It is respectfully submitted that the Srinivasan ‘441 application fails to disclose or suggest the claimed invention.

The invention, as defined by the current independent claims, relates to an additive composition (and to fluids including such an additive as well as to methods of using such additives and fluids) which includes at least one dispersant. The first is a dispersant which contains both phosphorus and boron. The second dispersant also contains boron, but is free of phosphorus.

This is not disclosed or suggested in the Srinivasan ‘441 application. Srinivasan ‘441 discloses the use of either a phosphorus-containing dispersant or a boron containing dispersant (§ 0046). Most preferably, Srinivasan ‘441 discloses the use of a *single* dispersant which includes both phosphorus and boron (§ 0058 and Table I). Srinivasan ‘441 nowhere discloses or suggests

the use of two separate dispersants, the first of which includes both phosphorus and boron while the second includes boron but not phosphorus as called for in the current claims. Thus the Srinivasan '441 application taken alone could not possibly have led one of ordinary skill in the art to the claimed invention. Accordingly, it is submitted that the obviousness rejections based upon Srinivasan '441 are improper and should be withdrawn.

Rejections Based on the Chrisope Patent and the Srinivasan '441 Application.

The Examiner's second set of obviousness rejections are based upon the Chrisope patent taken in combination with the Srinivasan '441 application. It is respectfully submitted that this combination of references also fails to disclose or suggest the claimed invention

The invention defined by the present independent claims calls for the use of an additive which includes a metal-containing, overbased detergent. The Chrisope patent, which is understood to be the Examiner's primary reference, does not disclose or suggest the use of an overbased detergent, as the Examiner concedes. Further, the Chrisope patent would clearly lead one of ordinary skill away from the use of a metal-containing detergent. In fact, the entire point of the Chrisope patent is to provide a composition which is "devoid" of metal-containing components (Col. 1, lines 33 - 34). See also Claims 1 and 17, the only independent claims of the Chrisope patent. Both claims explicitly specify a composition which is "devoid or essentially devoid of metal-containing components." While the Chrisope patent may make passing reference to "metal-containing detergents" (Col. 12, lines 5 - 10), their use is clearly non-preferred according to Chrisope.

Thus, if one of ordinary skill were to attempt to combine the teachings of Chrisope with those of the Srinivasan '441 application, he or she would not have used metal-containing detergents. Instead, one of ordinary skill would have been led by Chrisope to use a detergent which was devoid of metals in accordance with the clear aim of the Chrisope primary reference. The Federal Circuit has clearly indicated that if a proposed modification to the art would render it "inoperable for its intended purpose", the reference, "in effect ... teaches away from the ... proposed modification." *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984).

Further, one of ordinary skill would have had no motivation to use an overbased detergent. Once again, Chrisope does not disclose an overbased detergent and Srinivasan '441 only refers to the use of overbasing in the context of the metal-containing detergents. Chrisope

would have lead one of skill away from the use of metal-containing detergents so there would have been no reason use the overbasing of Srinivasan '441 in the metal-free compositions taught as preferred in Chrisope.

Moreover, neither reference disclose or suggests the use of a first dispersant which contains both phosphorus and boron in combination with a second dispersant which also contains boron, but is free of phosphorus. The failings of Srinivasan '441 in this regard are discussed above. The Chrisope patent likewise fails to disclose or suggest this limitation of the claims. Thus the combination of Chrisope and Srinivasan '441 could not have led one of ordinary skill in the art to the claimed invention. Accordingly, it is submitted that the obviousness rejections based upon this combination of references are improper and should be withdrawn.

Rejections Based on the Srinivasan '236 Patent and the Srinivasan '441 Application.

The Examiner's final set of obviousness rejections are based upon the Srinivasan '236 patent taken in combination with the Srinivasan '441 application. It is respectfully submitted that this combination of references like fails to disclose or suggest the claimed invention.

The failures of this combination of references are similar to those discussed above with respect to the combination of Chrisope and Srinivasan '441. As with the Chrisope patent, the stated intention of the Srinivasan '236 patent is to provide a fluid composition having "little or no content of metals" (Col. 1, lines 35 – 37). Although the Srinivasan '236 patent refers to the possibility of using "very small amounts" of metal-containing detergents, the overall teaching of the reference would lead one of ordinary skill away from the use of any metal-containing detergent. The teachings of a prior art reference must be taken as a whole. *In re Wesslau*, 353 F.2d 238 (CCPA 1965).

Further, the Srinivasan '236 patent teaches away from the use of overbased detergents. According to Srinivasan '236, any detergents used are preferably "neutral salts" (Col. 12, line 33).

In addition, the Srinivasan '236 patent, like the Chisope patent and the Srinivasan '441 application, fails to disclose or suggest the use of two dispersants in combination with one another wherein the first dispersant contains both phosphorus and boron while the second dispersant which also contains boron, but is free of phosphorus.

Thus the combination of Srinivasan '236 and Srinivasan '441 could not have led one of ordinary skill in the art to the claimed invention. Accordingly, it is submitted that the obviousness rejections based upon this combination of references are improper and should be withdrawn.

In light of the foregoing, Applicants urge the Examiner to reconsider the application, to withdraw the rejections, and to issue a notice of allowance at the earliest possible convenience.

In the event this response is not timely filed, Applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to our Deposit Account No. 12-2355.

Respectfully submitted,

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